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FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022				HARPER, ELIYAH STONE
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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte PETER GERNOLD

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Appeal 2009-011047  
Application 10/784,196  
Technology Center 2100

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Before MAHSHID D. SAADAT, ALLEN R. MacDONALD and  
ROBERT E. NAPPI, Administrative Patent Judges.

MacDONALD, Administrative Patent Judge.

DECISION ON APPEAL

## STATEMENT OF CASE

### Introduction

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-3, 5-7, 10-13, 15-17, 19, and 20. We have jurisdiction under 35 U.S.C. § 6(b).

### Exemplary Claim(s)

Exemplary claim 1 under appeal reads as follows:

Claim 1. A computer-readable medium having embodied thereon a computer program configured to generate data subscriptions, the medium comprising one or more code segments configured to:

receive user input identifying a publication to be used to create data subscriptions, the publication being one of multiple predetermined publications identifying a type of data capable of being distributed to data sites;

receive user input identifying a distribution criterion by which data is to be distributed to data sites by subscriptions automatically generated without human intervention;

store, in computer-readable medium for later access, subscription-generation information including the identified publication and the identified distribution criterion;

access, using a first computer system, the subscription-generation information identifying the publication and the distribution criterion;

access, using the first computer system and the accessed subscription-generation information, application data of various data types, including the type of data identified by the subscription-generation information;

generate, using the first computer system, data subscriptions for the publication to be distributed to data sites corresponding to computer systems that are distinct from the first computer system, the computer systems and the first computer system being connected in a network of distributed computer systems operating an application program having the application data of the various data types, wherein each data subscription 1) is generated automatically by the first computer system based only on the type of data to be distributed to data sites, the accessed application data, and the distribution criterion and 2) identifies a portion of the application data to be distributed to one or more of the data sites of the second computer system;

generate assignments of data sites to the generated data subscriptions, the assignments being generated based on application data, using the first computer system, and automatically without human intervention;

store, in computer-readable medium for later access, the generated assignments; and

distribute a portion of the application data to the data sites corresponding to computer systems, the distribution being based on the data subscriptions generated by the first computer system and the generated assignments.

#### Rejections on Appeal

The Examiner rejected claims 1-3, 5-7, 10-13, 15-17, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bracho (US 5,870,605) and Cheng (US 5,884,324).

#### Appellant's Contention

Appellant contends that the Examiner erred in rejecting the claims under 35 U.S.C. § 103(a) as being unpatentable over the combination of Bracho and Cheng because:

Moreover, the Bracho system does not generate, based on application data and using the first computer system, assignments of data sites to the generated data subscriptions automatically without human intervention. Instead, in the Bracho system, a subscriber reviews published events available through the Bracho system and decides which of the published events the subscriber wishes to receive. See Bracho at col. 5, lines 9-30 and col. 6, lines 1-12. In this regard, generated subscriptions are not assigned to data sites automatically without human intervention.

(App. Br. 6)(emphasis omitted).

#### Issue on Appeal

Did the Examiner err in rejecting claims 1-3, 5-7, 10-13, 15-17, 19, and 20 as being obvious because Bracho does not teach or suggest the argued generating limitation?

#### ANALYSIS

Appellant presents numerous arguments as to why the Examiner has erred. (App. Br. 5-10).

We agree with the Appellant's above specifically cited contention.

#### CONCLUSIONS

- (1) Appellant has established that the Examiner erred with respect to the rejection of claims 1-3, 5-7, 10-13, 15-17, 19, and 20 under § 103(a).
- (2) On this record, claims 1-3, 5-7, 10-13, 15-17, 19, and 20 have not been shown to be unpatentable.

DECISION<sup>1</sup>

The Examiner's rejections of claims 1-3, 5-7, 10-13, 15-17, 19, and 20 are reversed.

REVERSED

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<sup>1</sup> We have decided the appeal before us. However, should there be further prosecution of these claims; the Examiner's attention is directed to recently issued guidance from the Director.

Should there be further prosecution with respect to claims 1-3, 5-7, 10-13, 15-17, 19, and 20, the Examiner's attention is directed to Ariad Pharms., Inc. v. Eli Lilly & Co, 598 F.3d 1336 (CAFC 2010)(en banc), and 76 Fed. Reg. 7162, 7170-71 (Feb. 9, 2011) at Part 2.I.; Suppl. Examination Guidelines for Determining Compliance with 35 U.S.C. 112 and for Treatment of Related Issues in Patent Applications.

Should there be further prosecution with respect to claims 7 and 10-13, the Examiner's attention is directed to Aristocrat Techs. Australia Pty Ltd. v. Int'l Game Tech., 521 F.3d 1328 (CAFC 2008), and 76 Fed. Reg. 7162, 7167-68 at Part 1.III. C.1-3.

Should there be further prosecution with respect to claims 1-3 and 5-6, the Examiner's attention is directed to In re Nuijten, 500 F.3d 1346 (CAFC 2007), and 1351 Off. Gaz. Pat. Office 212 (Feb. 23, 2010); Subject Matter Eligibility of Computer Readable Media.